(3) It would not have been obvious to one of ordinary skill in the compiler art to change the disclosed Lawrence system to have the proposed modes of operation contemplated in Pages 7 and 8 of the Office Action.

Furthermore, it is respectfully submitted that the Lawrence patent does not constitute a valid anticipatory reference in that it fails to disclose any hardware or software whatever for performing any of the functions mentioned therein and upon which the Action relies. The draftsman of the Lawrence specification apparently recognized the need for a disclosure of hardware and/or software by attempting to "incorporate by reference" two pending European patent applications. However, both the MPEP and court decisions make it clear that this attempt is improper and of no effect. As stated by the Court of Appeals for the Federal Circuit in Quaker City Gear Works, Inc. v. Skil Corporation (CAFC 1984) 223 USPQ 1161 at Page 1167:

> "...Judge Green did note that the Manual of Patent Examining Procedure 608.01(p)(B) restricts the incorporation by reference of 'essential material' to that found in (1) a U.S. patent or (2) an allowed U.S. application.
> "Quaker City's argument is that the above referenced section was added to the MPEP after the pendency period of the Roth patent application. Skil's counter argument is that 35 U.S.C. 112, first paragraph, has always required an adequate disclosure.
> "The restriction on incorporation by reference set forth in 608.01(p)(B) is immaterial to resolution of a case such as the present one, where an unavailable reference has been incorporated by reference. Incorporation by reference has never been permissible under 35 U.S.C. 112 of material necessary for an adequate disclosure which is unavailable to the public."

If the Examiner adheres to the rejection on Lawrence it is respectfully requested that the Examiner designate

2

specifically, by drawing reference numerals and specification line numbers, wherein this patent discloses hardware or software for performing each of the functions relied upon as anticipating or suggesting any aspect of applicant's claims.

Paragraph 7 of the Office Action rejected 23 claims for alleged indefiniteness. It is respectfully submitted that many of the assertions of indefiniteness in the Action manifest three sources of error:

First, the failure to recognize that the recitation of a "means plus function" clause includes all the necessary structure and connections to perform the specified function;

Second, the confusion of breadth with indefiniteness; and

Third, the confusion of the disclosure function of the specification with the "metes and bounds" function of the claims.

In Ex parte Wolfskill (Bd App 1953) 97 USPQ 176 the Board of Appeals held:

> "As we understand the rejection, the examiner holds that the claims are incomplete because they do not include structure to operably connect the various means together into an operable relationship of elements. In other words, the examiner holds that the phrases beginning with "means for" and "spring for" merely point out the intended purpose of the "means" and "spring" and since the claims do not recite structure which associates such means in proper relationship to form an apparatus for lapping piezoelectric crystals, the claims may be construed as merely listing a catalog of disconnected elements. *** We are of the opinion that the facts in the claims on appeal differ from those considered in the decision relied on, for the following reason: in the claims on appeal, the recitation of "means for" followed by a statement of function, is not necessarily limited to a single element, but includes all the necessary structure and connections properly related to perform such function. *** We, therefore, do not sustain the rejection of claims 1, 2 and 4 to 8, inclusive, on this ground." (Emphasis added.)

The breadth of a claim is not to be equated with indefiniteness. Ex parte Schundehutte & Trautner (PO BdApp) 184 USPQ 697. A failure to include limitations is ordinarily merely the mark of a broad claim, whereas a proper rejection for indefiniteness requires that the claim language be unintelligible or ambiguous or of uncertain scope. Ex parte Durdin (PO BdApp) 74 USPQ 317. A claim in the mechanical or electrical arts may be drawn as broadly as permitted by the prior art. Ex parte Branham (PO BdApp) 67 USPQ 52; Ex parte Scheerer & Locklair (PO BdApp) 61 USPQ 456.

The designation of details required for operability is the function of the specification, not the claims. In re Fuetterer (CCPA) 138 USPQ 217. That other unrecited elements would be necessary to produce a complete operative machine does not render a claim indefinite. In re Gartner & Roeber (CCPA) 106 USPQ 273. That claims recite a condition or property without reciting every step necessary to obtain that condition or property does not render the claims indefinite. In re Roberts & Burch (CCPA) 176 USPQ 313; In re Alul & McEwan (CCPA) 175 USPQ 700. It is the function of the specification, rather than the claims, to detail how the invention is to be practised. In re Roberts & Burch, supra.

The claims are required only to particularly point out the subject matter which the applicant regards as his invention, so as to set definite boundaries on the patent protection sought. In re Wakefield & Foster (CCPA) 164 USPQ 636. The requirement of 35 U.S.C. 112 is met where the metes and bounds of the claimed subject matter can be readily ascertained. Ex parte Barber,

Brandenburg and Frost (PO BdApp) 187 USPQ 244; In re Conley, Catherwood & Lloyd (CCPA) 180 USPQ 454; In re Spiller (CCPA) 182 USPQ 614.

The rejections on indefiniteness of Claims 27, 31, 36, 38 and 46 were based, at least in part, upon an alleged lack of "connection" between the recited means.

The Wolfskill decision quoted above makes it clear that this ground of rejection is untenable. In that case also the examiner held that the claims were indefinite "because they do not include structure to operably connect the various means together into an operable relationship." In reversing the Board held that a means-plus-function clause "includes all the necessary structure and connections properly related to perform such function."

The indefiniteness rejections of Claims 26, 27, 30, 31, 32, 39, 43 and 48 were based, at least in part, upon an alleged lack of "knowledge" by the various recited means of respective events such as (1) entry of a source code byte, (2) the striking of a key, (3) the "time to compile", (4) the finish of an operation, and (5) the modification of the code.

It is respectfully submitted that several of these comments manifest a lack of understanding of the subject invention in that the recited means are neither required nor supposed to "know" the respective events identified by the Examiner.

More specifically, the compiler is not required to "know"

the "time to compile". As disclosed, the compiler always has control of the processor and is continuously executing instructions except when it is interrupted. As a result, the compiler is inevitably operable during each of the time intervals between keystrokes, without any requirement of "knowledge" of the "time to compile".

Furthermore, the compiler has no requirement whatever of "knowledge" that a key has been struck. When this event occurs the interrupt mechanism takes control away from the compiler irrespective of what the compiler may or may not "know".

The other recited means inherently include, by definition, "all the necessary structure and connections properly related to perform" their respective functions, as stated by the Board of Appeals in Ex parte Wolfskill, supra. This includes, by definition, all "structure and connections properly related" to "know" whatever they are required to "know" to perform their specified functions.

The indefiniteness rejections of Claims 31, 38, 42, 46 and 47 were based, at least in part, upon an alleged failure to identify where the pause point will be "advanced". The latter term must be interpreted in the light of the specification which makes it clear that "advanced" is in the direction away from the beginning and toward the end of the source code.

Exactly how far the pause point is to be advanced is not a necessary limitation, since it will be obvious to one of ordinary skill that the pause point may be advanced a line at a time, or token by token, or space by space, or even a single byte

6

at a time. In the disclosed embodiment the code for advancing the pause mark was invoked by the routine which serviced the carriage return because this arrangement would be more tolerant of errors by an inexpert typist, but this pause mark advancing code could just as well have been invoked whenever some other frequent repetitive event occurred, such as the recognition in the source code of a token, space or byte.

In any event, there is no prior art which requires that the claims be limited to specify exactly how far the pause mark moves at each advance.

The indefiniteness rejection of Claim 31 included comments that the limitations "contradict the limitation recited in claim 30", and the rejection of Claim 50 comments that "the claimed limitations contradict with [sic] each other." It is respectfully submitted that these comments are inaccurate, as explained below.

There is no contradiction between the recitation that the compiler normally has control of the system for compiling except while interrupted and the recitation that the compiler pauses until the pause point is changed. While the compiler is at the pause point it still has control of the system. That is, the compiler is executing instructions in an infinite loop. These instructions are part of a routine in the lexical analyzer. Therefore, in the preferred embodiment disclosed in the specification the compiler is always operable except while interrupted.

Several comments in the indefiniteness rejections are not

7

clear to applicant, as discussed below.

The rejections of Claims 34, 40 and 44 questioned the meaning of "controlling the extent of the source code compiled by said compiler." The alleged ambiguity is neither specified nor understood by applicant. The editor moves the pause mark forward and back and thereby controls the amount of source code compiled before the compiler reaches the pause mark.

The rejection of Claim 27 questions, "how would the passing means pass control of the CPU to the entering means?" Applicant is unaware of any prior art which requires the recitation of specific details as to "how" control is passed.

The rejection of Claims 38 and 42 assert that "there is no indication that a source code has been entered." However, Claim 36, upon which Claim 38 depends, recites at Line 5, "for entering source code into said buffer means", and Claim 39 upon which Claim 42 depends, recites at Line 10, " for entering a source code byte into said buffer means."

The provisional rejection on double-patenting is noted and will be obviated by the filing of a terminal disclaimer when the time is appropriate.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

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